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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,390	08/02/2001	Jeffrey Yu	021106-000210US	7476

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TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER	
PASS, NATALIE	
ART UNIT	**PAPER NUMBER**
3626	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/922,390	YU, JEFFREY	
	Examiner	Art Unit	
	Natalie A. Pass	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 November 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *24-28 and 31-50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24-28 and 31-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 November 2006 has been entered.

2. This communication is in response to the Request for Continued Examination and amendment filed on 30 November 2006. Claims 1-23, 29-30 have been cancelled. Claims 47-50 have been newly added. Claims 24-28, 31-50, remain pending.

Claim Objections

3. Claims 25 and 31 are objected to. Further reasons appear hereinbelow.

- Claim 25 is objected to for substantially the same reasons given in the previous Office Action (paper number 20060629). Claim 24 has not been amended, and continues to recite "wherein the steps of receiving each includes" in lines 1-2. For the purpose of applying art, Examiner assumes claim 25 to read, "wherein the steps of receiving each selection includes."
- Claim 31 is objected to because it depends on canceled claim 30. For the purpose of applying art, Examiner assumes claim 31 to read "the method of claim 24."

Appropriate correction is required.

4. The objection to claim 41 is hereby withdrawn due to the amendment filed 30 November 2006.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Newly amended claims 24, 27, 32, 37-39, 44, 48-50 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Claims 24, 27, 32, 37-39, 44, 48-50 recite limitations that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows:

- "pre-defined," as disclosed in claims 24, 37, 44, and 48-50, at lines 2-3, 3, 3, 1, 1, and 1, respectively;
- "supplied," as disclosed in claims 24, 27, 32, 37, 38, 39, at lines 3, 2, 1, 4, 3, and 3, respectively.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and

b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable able to find any support for this newly added language within the specification as originally filed on 2 August 2001. Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

7. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 2 August 2001.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

NOTE: The following rejections assume that the subject matter added in 30 November 2006 amendment are NOT new matter, and are provided hereinbelow for Applicant's

consideration, on the condition that Applicant properly traverses the new matter objections and rejections made in sections 5-7 above in the next communication sent in response to the present Office Action.

9. Claims 24-26, 31-35, 37-42, 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al., U.S. Patent Application Publication Number 2001/0041992 in view of Jones et al., U.S. Patent Number 6, 516, 324 for substantially the same reasons given in the previous Office Action (paper number 20060629). Further reasons appear hereinbelow.

(A): Claim 24 has been amended to include the recitation of

- "[...] pre-defined [report] types [...]," at line 2;
- "[...] pre-defined associated [...]," and "[...] supplied [...]," at line 3; and
- "[...] the medical descriptions of the associated organs [...],"at lines 11-12.

As per newly amended claim 24, Lewis teaches a method as analyzed and discussed in the previous Office Action (paper number 20060629), comprising

presenting a list of pre-defined reports, each report comprising a plurality of pre-defined associated organs and containing supplied medical descriptions of the associated organs (Lewis; Figure 4A, , Figure 4B, Figure 5A, Figure 5B, paragraphs [0009]-[0010], [0049]- [0050], [0053], [0061], [0086]);

receiving selection information indicative of a selected report (Lewis; Figure 4A, paragraphs [0049]-[0050], [0053], [0061]);

presenting an organ list of associated organs corresponding to the selected report (Lewis; Figure 4A Item 404, paragraphs [0033], [0059], [0064]);

for each associated organ presenting a list of applicable medical descriptions and receiving a selected applicable medical description, wherein the selected applicable medical description is associated with said each associated organ (Lewis; Figure 4A, Figure 5A, Figure 5B, Figure 5C, paragraphs [0007]-[0010], [0050], [0056], [0085]-[0086]); and

outputting a "treatment plan" (reads on "patient report") comprising the medical descriptions of the associated organs in the selected report type (Lewis; Figure 4H, Item 486, paragraphs [0050], [0053], [0056], [0068], [107], [116]).

Although Lewis teaches "reports ... stored in the anatomic database" (Lewis; paragraph [0049]) and receiving selection information indicative of a selected report (see above), Lewis fails to explicitly disclose presenting a list of pre-defined report types and receiving selection information indicative of a selected report type.

However, the above features are well-known in the art, as evidenced by Jones.

In particular, Jones teaches a method comprising

presenting a list of pre-defined report types (Jones; Figure 3, column 6, lines 63-64, column 7, lines 22-47, column 8, lines 57-59, column 10, lines 8-16); and

receiving selection information indicative of a selected report type (Jones; Figure 3, column 6, lines 63-64, column 7, lines 22-47, column 8, lines 31-36, 57-59, column 10, lines 8-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Lewis to include these limitations, as taught by Jones, with the motivations of allowing a user to specify which report "category" (reads on "type") to view (Jones; column 3, lines 62-67, column 10, lines 8-20), providing "data access flexibility, an

intuitive user interface and exceptional report data retrieval and display performance" while allowing users to "specify all of the report content parameters and display the report on a single screen" (Jones; column 3, lines 18-20, 31-32).

(B) As per claims 25-26, 31-32, Lewis and Jones teach a method as analyzed and discussed in claim 24 above,

wherein the steps of receiving each includes receiving input from an operator (Lewis; Figure 5B, paragraphs [0007]-[0010]);

further comprising receiving a composed medical description and associating the composed medical description to one of the associated organs corresponding to the selected report (Lewis; paragraphs [0007]-[0010], [0048]-[0050], [0085]- [0086]);

wherein the list of report types is presented in a "point and click" or pop-up menu (Lewis; Figure 4H, Item 486, Figure 4I, Item 496, paragraphs [0110]-[0111]), (Jones; column 7, lines 29-35, column 8, lines 31-36, 57-59); and

wherein the list of supplied applicable medical descriptions is presented in a pop-up menu (Lewis; Figure 4H, Item 486, Figure 4I, Item 496, paragraphs [0032]-[0033], [0048]-[0050], [0056],[0110]-[0111]).

The motivations for combining the respective teachings of Lewis and Jones are as given in the rejection of claim 24 above, and incorporated herein.

(C) As per claims 33-35, 45, Lewis and Jones teach a method as analyzed and discussed in claim 24 above,

wherein outputting a patient report includes printing out the patient report (Jones; column 13, lines 38-39);

wherein outputting a patient report comprises displaying the patient report on a computer screen (Lewis; paragraph [0050)]), (Jones; column 13, lines 40-42);

wherein the organ list is presented in its entirety on a screen (Lewis; Figure 4H), (Jones; Abstract, column 3, lines 30-32); and

wherein the list of organs in the patient report comprises a subset of an organ list corresponding to the report type (Lewis; Figure 4A, Item 404, paragraphs [0033], [0054]-[0056] [0059], [0060], [0064]); Examiner interprets Lewis's teachings of "the patient database 97 will identify the anatomic structure the patient does or does not have" (Lewis; paragraph [0055]) and "provide the practitioner with only a subset of relevant, more easily navigable information" (Lewis; paragraph [0010]) as teaching a form of a "subset of an organ list."

The motivations for combining the respective teachings of Lewis and Jones are as given in the rejection of claim 24 above, and incorporated herein.

(D) Amended claim 37 differs from amended method claim 24, in that it is a system rather than a method for generating a patient report.

System claims 37-42, 46 repeat the subject matter of claims 24, 24, 32, 26, 31, 35, 45, respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 24, 24, 32, 26, 31, 35, 45 have been shown to be fully disclosed by the teachings of Lewis and Jones in the above rejection of claims 24, 24, 32, 26, 31, 35, 45, it is readily apparent that the system disclosed by Lewis and Jones includes the apparatus to perform these functions. As such,

these limitations are rejected for the same reasons given above for method of claims 24, 24, 32, 26, 31, 35, 45, and incorporated herein.

(E) Amended claim 44 differs from amended method claim 24 by reciting a "computer user interface..." in the preamble. As per this limitation, Lewis's system is inherently implemented on a computer, as it is directed to a computer-based system for accessing healthcare information (Lewis; paragraph [0012]) and contains use of a Web browser that displays Web pages that are generated by the anatomic user interface (Lewis; paragraph [0038]). As such, Lewis implicitly includes computer elements such as a computer user interface. The remainder of claim 44 repeats the limitations of claim 24, and is therefore rejected for the same reasons given above for claim 24.

(F) As per newly added claim 47, Lewis and Jones teach a method and system and computer user interface as analyzed and discussed in claims 24 and 37 and 44 above

wherein the list of organs in the patient report comprises a subset of an organ list corresponding to the report type (Lewis; Figure 4A, Item 404, paragraphs [0010], [0033], [0054]-[0056] [0059], [0060], [0064]); Examiner interprets Lewis's teachings of "the patient database 97 will identify the anatomic structure the patient does or does not have" (Lewis; paragraph [0055]) and "provide the practitioner with only a subset of relevant, more easily navigable information" (Lewis; paragraph [0010]) as teaching a form of a "subset of an organ list."

10. Claims 27-28, 36, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al., U.S. Patent Application Publication Number 2001/0041992 and Jones et al., U.S.

Patent Number 6, 516, 324 as applied to claims 24 and 26 above, and further in view of Vining et al., U.S. Patent Number 6, 819, 785.

(A) As per claims 27 and 28, Lewis and Jones teach a method as analyzed and discussed in claims 24 and 26 above.

Lewis and Jones fail to explicitly disclose wherein receiving a composed medical description includes

editing a supplied standard medical description; and

receiving a user provided description.

However, the above features are well-known in the art, as evidenced by Vining.

In particular, Vining teaches a method wherein receiving a composed medical description includes

editing a supplied standard medical description (Vining; column 4, lines 30-31, column 6, lines 31-41, 64-67); and

receiving "annotated" (reads on "user provided") description (Vining; column 7, lines 24-29).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined teachings of Lewis and Jones to include these limitations, as taught by Vining, with the motivations of providing a reporting system which offers a standardized report format, enables consistency among reports, accounts for effective information flow, provides for quick turnaround of information to the end-user, and supports data mining for public health statistics and yet enables the final report presentation to be further

customized to satisfy the needs of the clinician (Vining; column 1, line 62 to column 2, line 1, column 2, lines 44-46).

The motivations for combining the respective teachings of Lewis and Jones are as given in the rejection of claim 24 above, and incorporated herein.

(B) As per claim 36, Lewis and Jones teach a method as analyzed and discussed in claim 24 above.

Lewis and Jones fail to explicitly disclose further comprising generating a billing report associated with the selected report.

However, the above features are well-known in the art, as evidenced by Vining.

In particular, Vining teaches a method further comprising generating a billing report associated with the selected report (Vining; Abstract, column 2, lines 11-16, column 19, lines 25-26).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined teachings of Lewis and Jones to include these limitations, as taught by Vining, with the motivations of providing a reporting system that provides for quick turnaround of information to the end-user and of expediting hospital billing and collections (Vining; column 1, line 62 to column 2, line 1, column 2, lines 15-16).

(C) System claim 43 repeats the subject matter of claim 36 respectively, as a set of elements rather than a series of steps. As the underlying processes of claim 36 have been shown to be fully disclosed by the teachings of Lewis, Jones and Vining in the above rejection of claim

36, it is readily apparent that the system disclosed by Lewis, Jones and Vining includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 36, and incorporated herein.

(D) As per newly added claims 48-50, Lewis and Jones teach a method and system and computer user interface as analyzed and discussed in claims 24 and 37 and 44 above.

Lewis and Jones fail to explicitly disclose a method and system and computer user interface wherein the pre-defined report types may be customized by the operator.

However, the above features are well-known in the art, as evidenced by Vining.

In particular, Vining teaches a method and system and computer user interface wherein the pre-defined report types may be customized by the operator. (Vining; column 2, lines 44-46, column 14, lines 61-62); Examiner interprets Vining's teachings of "customize the display of the information to best suit their needs" as teaching a form of "report types may be customized by the operator."

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined teachings of Lewis and Jones to include these limitations, as taught by Vining, with the motivations of providing a reporting system that provides for quick turnaround of information to the end-user and of expediting hospital billing and collections (Vining; column 1, line 62 to column 2, line 1, column 2, lines 15-16).

The motivations for combining the respective teachings of Lewis and Jones are as given in the rejection of claim 24 above, and incorporated herein.

Response to Arguments

11. Applicant's arguments filed 30 November 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 30 November 2006.

(A) At pages 7-9 of the 30 November 2006 response, Applicant argues that the limitations of claims 24-28 and 31-50 are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references, including the newly added limitations of claims 24-28 and 31-50 have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Lewis, Jones, and Vining, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 20060629), and incorporated herein. In particular, Examiner notes that the newly added limitation of "presenting a list of pre-defined report types" is taught by the applied references. In particular, please note (Jones; Figure 3, column 6, lines 63-64, column 7, lines 22-47, column 8, lines 57-59, column 10, lines 8-16), as specifically applied in the rejections given above and incorporated herein. Please note that Examiner interprets Jones's teachings of "[t]he desired [report] category [reads on "type"] can be selected by clicking on a drop-down pick list which is displayed when the user clicks on display field 58 shown in FIG. 3" (Jones, column 10, lines 11-14) as teaching a form of "presenting a list of pre-defined report types."

As per Applicant's argument on page 8 of the 30 November 2006 response, that the Lewis reference "does not teach or even suggest," the limitation of "presenting a list of pre-defined report types" Examiner respectfully notes that it was the Jones reference, and not the Lewis reference that was applied to teach this limitation, as noted in the preceding paragraph.

As per Applicant's argument on page 8 of the 30 November 2006 response, that the applied art "does not teach or even suggest," the limitations of "each report type comprising a plurality of pre-defined associated organs and containing supplied medical descriptions of the associated organs," Examiner respectfully disagrees. In this regard, Examiner notes that, as noted above, Jones's teaches "[t]he desired [report] category [reads on "type"] can be selected by clicking on a drop-down pick list which is displayed when the user clicks on display field 58 shown in FIG. 3" (Jones, column 10, lines 11-14). Jones further teaches that "[e]ach category of report provides the user with a list of reports that contain information related to the category" (emphasis added) (Jones column 10, lines 14-16) and "[w]hen the user selects a Standard Reports link on the home web page, the Standard Reports screen 40 (shown in FIG. 3) will be displayed. The parameters ... [...] ...will be used to retrieve the appropriate chart" (Jones, column 10, lines 24-30). Furthermore, Jones teaches "a report delivery system" that utilizes "medical facility profile data read from a customer/facility database 6" (Jones; column 4, lines 50-54). Examiner interprets these teachings, together with Lewis's teachings of retrieval of "healthcare information" where "the anatomic data model 84, the constraint engine 82, etc., use the anatomic structures to eliminate irrelevant healthcare information and provide the user with ... [...] ... a subset of context-relevant... [...] ... information"] (Lewis; paragraph [0059]) and Lewis's

teachings of "healthcare information from a vast variety of resources can be associated with each anatomic structure maintained in the anatomic database 42. For example, using the anatomic user interface of the present invention, a user may access healthcare information from a multitude of diverse resources, including patient medical histories, medical libraries, medical references, books and databases, physician databases, medication and pharmaceutical databases, picture archive communication systems ("PACS"), radiology information systems ("RIS"), appropriateness guidelines, and remote triage reports for emergency medical care, insurer bulletins, medication formularies, etc." (Lewis; paragraph [0049]) and Lewis's teachings of "[w]hen viewed in the aggregate, the order information stored in the patient database 97 for each patient produces a medical history for the patient. Since the order information stored in the patient database 97 is associated with a particular anatomic structure, the order information, and thus a patient medical history, can be accessed in an anatomic context by the user and displayed by the anatomic user interface 58" (Lewis, paragraph [0054]) as teaching the argued limitations.

As per Applicant's argument at paragraph 3 on page 8 of the 30 November 2006 response that in the Jones reference "there is no teaching that would suggest a report about the medical conditions of a body section, Examiner respectfully disagrees, and notes that Jones teaches "[t]his invention relates generally to centralized generation of reports which compile and/or summarize operational data from remotely located user-operated electronic devices, for example, imaging devices used for medical diagnosis" (Jones; column 1, lines 7-10) (emphasis added) and "offer the physician a range of techniques for imaging particular types of tissue, organs, physiological systems, etc. Health care institutions often arrange several such imaging systems at

a single facility or at multiple facilities, permitting its physicians to draw upon such resources as required by particular patient needs" (Jones; column 1, lines 29-34) (emphasis added).

At pages 8-9 of the 30 November 2006 response, Applicant analyzes the applied references separately and argues each of the references individually. In response to Applicant's piecemeal arguments analysis of the references, it has been held that one cannot show nonobviousness by attacking references individually where, as here, the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

At pages 8-9 of the 30 November 2006 response Applicant argues that the there is no motivation to combine the references. In response, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki,* 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence of corresponding claim elements in the prior art has been presented and since Examiner has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention. Note, for example, the motivations explicitly stated at the paragraph bridging pages 6-7 above (i.e., " ... with the motivations of allowing a user to specify which report ...") (Jones; column 3, lines 62-67, column 10, lines 8-20).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5

USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti* et al 192 USPQ 278 (CCPA) that:

(i) obvious does not require absolute predictability;

(ii) non-preferred embodiments of prior art must also be considered; and

(iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Applicant appears to view the applied references separately, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references DeBusk et al., U.S. Patent Application Publication Number 2001/0016821, Coli et al. U.S. Patent Number 6018713, Shepard, U.S. Patent Number 6026363, Filler, U.S. Patent Application Publication Number 2001/0051881, Zak et al., U.S. Patent Application Publication Number 2002/0004729 teach the environment of generating and editing medical reports.

13. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication. After Final communications should be labeled "Box AF."

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NP

Natalie A. Pass

January 7, 2007

Robert Morgan
Robert Morgan
Patent Examiner
Art Unit 3626